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Sharon L. Tabor
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Initial Review
BOX AF

B2 #29
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DEC 16 1996
GROUP 1100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT application of)
Hisato SHINOHARA et al)
Serial No. 08/169,127) Group Art Unit: 1112
Filed: December 20, 1993) Examiner: M. Padgett
For: METHOD AND SYSTEM OF)
LASER PROCESSING) December 9, 1996

PETITION FOR REVIEW OF
EXAMINER'S REFUSAL TO ENTER REPLY BRIEF

Assistant Commissioner for Patents
Box AF
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. 1.181, Appellants respectfully request that the Examiner's refusal (Paper No. 27; mailed October 8, 1996) to enter the Reply Brief filed July 1, 1996 be reconsidered and reversed, and the Reply Brief entered into the record.

The Examiner contends that the Reply Brief is not limited to "new points of argument or to new grounds of rejection", as required. However, the Reply Brief merely responds to new points of argument raised by the Examiner in the Answer. These new points of argument were made for the first time with respect to the interpretation given to the appealed claims. Moreover, the

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Examiner's arguments were directed as an objection to Appellants summary of invention in its Appeal Brief so it would seem that such arguments would have to be considered new points of argument which are ripe for response in a reply brief.

Specifically, the Answer contends that the *Summary of Invention* contained in the Appeal Brief is deficient in that Appellant's interpretation of the claims does not "fit" the appealed claims (Exhibit A, Section 5, lines 1-6). The Examiner's Answer also asserts that the Appellant's interpretation in the *Summary of the Invention* has only been proposed as of the unentered after final amendment of November 7, 1995 and thus the Appellant's interpretation is a new issue. However, the Examiner has never before asserted that Appellants' interpretation of the appealed claims does not "fit" the appealed claims. Moreover, the Examiner certainly has never before claimed that the *Summary of the Invention* contained in the Appeal Brief is deficient and that the interpretation of the appealed claims in the summary is a new issue which would be impossible.

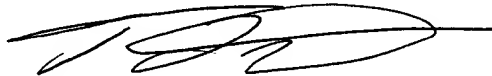
As clearly stated in the Reply Brief, Appellant's interpretation of the appealed claims, as set forth in the summary of the invention, is the same interpretation set forth by Appellant during prosecution. Appellant's interpretation of the appealed claims has not changed and remains supported by the original specification. The Examiner has waited until the Answer to the Appeal Brief to object to the interpretation Appellants have set forth throughout prosecution. The Examiner appears to have changed her own understanding of the Appellant's interpretation of the appealed claims and has reacted by indicating that this new understanding is a new issue. Regardless of the reason for the Examiner's "new issue" argument, for the first time the Examiner is

stating that an interpretation of the claims by Appellant both does not "fit" the appealed claims and is a new issue. Appellant's Reply Brief properly identifies (Exhibit B, page 1, lines 4-9), and is directed to, these new points of argument.

In view of the foregoing, Appellant respectfully requests that the Examiner's refusal to enter the Reply Brief filed July 1, 1996 be reversed and the Reply Brief entered into the record.

Enclosed is a check in the amount of \$130.00 to cover the requisite fee. The Commissioner is hereby authorized to charge fees under 37 CFR 1.16 and 1.17 (except the Issue Fee) which may be required now or hereafter, or credit any overpayment, to Deposit Account No. 19-2380.

Respectfully submitted,



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EXHIBIT A

Art Unit 1112

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

It is further noted that the concurrently filed amendment cancelling claims 5, 10 and 15 was entered.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because the appellants' interpretation of the claims, which they have only proposed as of the unentered after final amendment of November 7, 1995 is not agreed with. This interpretation is a new issue, which fits the unentered claims, not those under appeal. The wording of the claims as it is derived from the specification does not claim the configuration as shown in Fig. 1. As the examiner has maintained without previous depute from the first rejection, the claim of "condensing said masked laser beam in a second direction orthogonal to said first direction" requires the laser beam to be bent when its condensed because the direction modifiers are applied to the laser beam, not its shape i.e., cross-section, the condensing effects the overall size of the shape by shrinking the beam cross section. The first direction as introduced in claim 1, lines 4 also modifies the

EXHIBIT B

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) BOX AE
) Group Art Unit: 1112
) Examiner: M. Padgett
)
) July 1, 1996

REPLY BRIEF

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

The Examiner's answer has been received and its contents carefully reviewed. In view thereof, Appellant wishes to address a new point of argument raised in the answer.

The answer contends that the *Summary of Invention* contained in the brief is deficient in that Appellant's interpretation of the claims does not "fit" the appealed claims and, thus, the interpretation is a new issue. In asserting that Appellant's interpretation of the appealed claims is a new issue, the answer contends that the "wording of the claims as it is derived from the specification does not claim the configuration as shown in Fig. 1" of the specification. However, Appellant's interpretation of the claims as set forth in the summary of the invention is the same interpretation set forth by Appellant during